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09/909,040	07/19/2001	Kenichiro Matsuura	B588-022	8470

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EXAMINER

SINGH, SATWANT K

ART UNIT PAPER NUMBER

2626

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/909,040	Applicant(s) MATSUURA ET AL.	
	Examiner Satwant K. Singh	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/8/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-9, 14-17 19-29, 34-37, and 39-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Kirani et al. (US 2001/0016818).

3. Regarding Claim 1, Kirani et al discloses an information providing apparatus comprising: reception means (recipient 350) for receiving transmission information to a user (recipient receives e-mail) (page 7, paragraph [0095]); decision means (SMTP mail server 315) for deciding, on the basis of user information of the user, a destination of the transmission information received by said reception means (server determines the type of device the recipient is using) (page 5, paragraph [0065]); designation means (SMTP mail server 315) for designating conversion such that data contained in the transmission information matches a format of the destination (device capability determination includes determining a type and size of objects that the recipient's device can handle) (page 5, paragraph [0066]); and providing means (SMTP mail server) for providing to the destination data whose format is converted by the designation of said

designation means(mail server makes the adjusted or modified e-mail message available to the recipient) (page 5, paragraph [0064]).

4. Regarding Claim 2, Kirani et al disclose an information providing apparatus, wherein the apparatus further comprises division means (message originator 300) for dividing the data contained in the transmission information in accordance with types of contents of the data (message originator sends a message along with an attachment) (page 6, paragraph [0093]), said designation means designates the data divided by said division means so as to match the format of the destination (mail server performs automatic formatting of attachments (pages 5-6, paragraph [0069]), and said providing means integrates the data whose formats are converted on the basis of the designation of said designation means and provides the integrated data to the destination (mail server makes the adjusted or modified e-mail message available to the recipient) (page 5, paragraph [0064]).

5. Regarding Claim 3, Kirani et al disclose an information providing apparatus, wherein the transmission information is electronic mail, and the data divided in accordance with the types are attached files contained in the electronic mail (incoming email includes an attachment) (page 5, paragraph 0064]).

6. Regarding Claim 4, Kirani et al disclose an information providing apparatus, further comprising user information retention means (server) for retaining user information including designation of a destination of the transmission information for each user (server determines the type of device the recipient is using) (page 5, paragraph [0066]).

7. Regarding Claim 5, Kirani et al disclose an information providing apparatus, further comprising setting means for setting the user information (user-specified configuration settings) (page 5, paragraph [0065]).

8. Regarding Claim 6, Kirani et al disclose an information providing apparatus, wherein said designation means selects a conversion module on the basis of a data format of the data contained in the transmission information and a data format of the destination and makes the selected conversion module convert the data (determining a type and size of objects that the recipient's device can handle) (page 5, paragraph [0066]).

9. Regarding Claim 7, Kirani et al disclose an information providing apparatus, wherein said providing means integrates the converted data in accordance with a data order of the transmission information (attachments automatically formatted for a given type of client service) (page 5, paragraph [0068]).

10. Regarding Claim 8, Kirani et al disclose an information providing apparatus, wherein when the destination is a World Wide Web information providing apparatus (portable computing device operating in a wireless network with internet connectivity, for interaction with a desktop and/or server computer) (page 3, paragraph [0047]), said conversion module converts image data contained in the transmission information into JPEG data (JPEG or BMP or the like) and converts wordprocessor document data into HTML format data formatted/transformed for a given type of client device) (page 5, paragraph [0065]-[0069]).

11. Regarding Claim 9, Kirani et al disclose an information providing apparatus, wherein when the destination is a portable terminal (portable computing device) (page 3, paragraph [0047]), said conversion module converts image data contained in the transmission information into a format displayable on the portable terminal and converts wordprocessor document data into text string data representing a subject of the document (formatted/transformed for a given type of client device) (page 5, paragraph [0068], [0069]).

12. Regarding Claim 14, Kirani et al disclose an information providing apparatus, wherein the apparatus further comprises acquisition means for acquiring a capacity of the destination decided by said decision means, and said designation means designates to convert the transmission information into a format matching an output capacity of the destination (device capability determination) (page 5, paragraph [0066]).

13. Regarding Claim 15, Kirani et al disclose an information providing apparatus, wherein the apparatus further comprises apparatus type information retention means for retaining apparatus type information representing a capacity of each apparatus type for apparatuses serving as destinations, and said acquisition means acquires a capacity of the destination on the basis of the registration contents of said apparatus type retention means (user-specified configuration settings) (page 5, paragraph, [0065]).

14. Regarding Claim 16, Kirani et al disclose an information providing apparatus, wherein when the destination is a World Wide Web information providing apparatus, said providing means retains the output data accessible by a URL (Fig. 6).

15. Regarding Claim 17, Kirani et al disclose an information providing apparatus, wherein when the destination is a portable terminal, said providing means transmits the output data to the portable terminal (portable computing device) (page 3, paragraph [0047]).

16. Regarding Claim 19, Kirani et al disclose an information providing apparatus comprising: user information retention means (server) for retaining user information including designation of a destination of transmission information for each user (configuration information) (page 5, paragraph [0066]); reception means (recipient 350) for receiving transmission information to a user (recipient receives e-mail) (page 7, paragraph [0095]); decision means (mail server 315) for acquiring user information of the user from said user information retention means and deciding the destination of the received transmission information on the basis of the user information (server determines the type of device the recipient is using) (page 5, paragraph [0065]); conversion means (mail server 315) for converting data contained in the transmission information so as to match a format of the destination (attachments automatically formatted/transformed for a given type of client device) (page 5, paragraph [0068]); and providing means for providing the format-converted data to the destination (mail server makes the adjusted or modified e-mail message available to the recipient) (page 5, paragraph [0064]).

17. Regarding Claim 20, Kirani et al disclose an information providing apparatus, wherein the system further comprises division means (message originator 300) for dividing the data contained in the transmission information in accordance with types of

contents of the data (message originator sends a message along with an attachment) (page 6, paragraph [0093]), said designation means designates the data divided by said division means so as to match the format of the destination (mail server performs automatic formatting of attachments (pages 5-6, paragraph [0069]), and said providing means integrates the data whose formats are converted on the basis of the designation of said designation means and provides the integrated data to the destination (mail server makes the adjusted or modified e-mail message available to the recipient) (page 5, paragraph [0064]).

18. Claims 21 and 41 are rejected for the same reason as claim 1.
19. Claim 22 is rejected for the same reason as claim 2.
20. Claim 23 is rejected for the same reason as claim 3.
21. Claim 24 is rejected for the same reason as claim 4.
22. Claim 25 is rejected for the same reason as claim 5.
23. Claim 26 is rejected for the same reason as claim 6.
24. Claim 27 is rejected for the same reason as claim 7.
25. Claim 28 is rejected for the same reason as claim 8.
26. Claim 29 is rejected for the same reason as claim 9.
27. Claim 34 is rejected for the same reason as claim 14.
28. Claim 35 is rejected for the same reason as claim 15.
29. Claim 36 is rejected for the same reason as claim 16.
30. Claim 37 is rejected for the same reason as claim 17.
31. Claims 39 and 42 are rejected for the same reason as claim 19.

32. Claim 40 is rejected for the same reason as claim 20.

Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. Claims 10, 18, 30 and 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Kirani in view of Naylor et al. (US 6,625,642).

35. Regarding Claim 10, Kirani et al fail to teach an information providing apparatus, wherein when the destination is a facsimile machine, said conversion module converts text data, image data, and wordprocessor document data contained in the transmission information into facsimile data by CCITT FAX encoding.

Naylor et al teach an information providing apparatus, wherein when the destination is a facsimile machine, said conversion module converts text data, image data, and wordprocessor document data contained in the transmission information into facsimile data by CCITT FAX encoding (Fig. 1, server 30) (server 20 communicates with the transmitting fax device in accordance with facsimile communications as defined by CCITT) (col. 8, lines 44-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Kirani with the teaching Naylor to allow users to receive a fax via a LAN connection.

36. Regarding Claim 18, Kirani et al fail to teach an information providing apparatus, wherein when the destination is a facsimile machine, said providing means transmits the output data to the facsimile machine.

Naylor et al teach an information providing apparatus, wherein when the destination is a facsimile machine, said providing means transmits the output data to the facsimile machine (Fig. 1, Fax 1-Fax n).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Kirani with the teaching Naylor to allow users to receive a fax via a LAN connection.

37. Claim 30 is rejected for the same reason as claim 10.

38. Claim 38 is rejected for the same reason as claim 18.

39. Claim 11 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirani et al. and Naylor et al. as applied to claim 10 above, and further in view of Toyoda et al. (US 6,493,07).

40. Regarding Claim 11, Kirani et al and Naylor et al fail to teach an information providing apparatus, wherein the apparatus further comprises cover page generation means for generating cover page data describing an address of a data destination, on the basis of the user information, and said providing means attaches the cover page data to the facsimile data obtained by said conversion module to form the output data.

Toyoda et al teach an information providing apparatus, wherein the apparatus further comprises cover page generation means for generating cover page data describing an address of a data destination, on the basis of the user information, and

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said providing means attaches the cover page data to the facsimile data obtained by said conversion module to form the output data (cover sheet is added to the converted data) (page 26, lines 14-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Kirani and Naylor with the teaching of Toyoda to add to a cover page the destination information for the converted information.

41. Claim 31 is rejected for the same reason as claim 11.

42. Claims 12, 13, 31 and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Kirani in view of Barber (US 5,930,777).

43. Regarding Claim 12, Kirani et al fail to teach an information providing apparatus, further comprising charging means for, when said conversion module executes conversion which accrues charge, executing charge processing.

Barber teaches an information providing apparatus, further comprising charging means for, when said conversion module executes conversion which accrues charge, executing charge processing (tokenized link) (col. 4, lines 65-67, col. 5, line 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teaching of Kirani with the teaching of Barber to only charge a fee when information is decoded.

44. Regarding Claim 13, Kirani et al fail to teach an information providing apparatus, further comprising inhibiting means for, when a user sets to inhibit charge, inhibiting conversion which accrues charge.

Barber teaches an information providing apparatus, further comprising inhibiting means for, when a user sets to inhibit charge, inhibiting conversion which accrues charge (not accessing tokenized link) (col. 4, lines 65-67, col. 5, line 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teaching of Kirani with the teaching of Tsumura to only charge a fee when information is decoded.

Conclusion

45. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ho et al. (US 6,061,502) discloses a communications device that transmits and receives information in accordance with both facsimile and electronic mail communications protocols.

Motoyama (US 6,330,628) discloses a method and system which allows a remote monitoring and diagnostic computer or system to communicate using different communication protocols which are stored within a data base.

Onuma (US 6,493,105) discloses an Internet facsimile apparatus with a format converting section which converts image data to e-mail, and a mail transmission section which transmits the e-mail via a network.

Baker (US 6,546,417) discloses an enhanced electronic mail system including methods and apparatus for identifying mime types and for displaying different icons.

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Toyoda et al. (US 6,683,698) discloses a relaying apparatus that relays an e-mail to a facsimile destination.

Halami (US 6,684,088) discloses a system and method for displaying electronic mail messages on a low bandwidth device.

Kato (US 6,775,026) discloses an Internet facsimiles system capable of data communication over the Internet.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Satwant Singh
sks

Satwant K. Singh
Examiner
Art Unit 2626

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